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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,684	09/29/2003	Allen I. Bain	554792000401	5115

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EXAMINER

ANDERSON, REBECCA L

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/674,684	Applicant(s) BAIN ET AL.	
	Examiner Rebecca L. Anderson	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 160-170 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 160-170 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/04, 12/04, 1/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 160-170 are currently pending in the instant application. Claims 160-170 are objected.

Election/Restrictions

Applicant's amendment to the claims by canceling claim 1 and adding new claims 160-170 and the further election of the compound, 2-(4-morpholinyl)-1-(3,4-dichlorophenoxy)cyclohexane, in the reply filed on 21 December 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Therefore, as stated on page 3 of the restriction requirement, **the elected invention for search and examination is:**

The products of the formula (I) wherein :

X is as found in claim 1;

Y is as found in claim 1;

R13 is as found in claim 1;

R1 and **R2**, taken together with the nitrogen atom to which they are directly attached in formula (I) form a morpholinyl ring where any one or more of the carbon ring atoms may be substituted with one to two substituents selected from hydrogen, hydroxyl, C1-C3hydroxyalkyl, oxo, C2-C4acyl, C1-C3alkyl, C2-C4alkylcarboxy, C1-C3alkoxy, C1-C20alkanoyloxy;

R3 and **R4** are as found in claim 1;

R5, R6 and R14 are as found in claim 1; and

A is as found in claim 1

The remaining subject matter of claims 160-170 that is not drawn to the above elected invention stands withdrawn under 37 CFR 1.142(b) as being for non-elected subject matter. The remaining products which are not within the elected invention, which are independent and distinct from the elected invention and do not have unity with the elected compound and are therefore withdrawn by means of a restriction requirement within the claims are, for example, the products of the formula (I) wherein R1 and R2, when taken together with the nitrogen atom to which they are directly attached in formula (I) form a ring selected from pyrrolidinyl, 2-ketopyrrolidinyl, 3-ketopyrrolidinyl, 2-acetoxypyrrolidinyl, 3-acetoxypyrrolidinyl, 2-hydroxypyrrolidinyl, 3-hydroxypyrrolidinyl, thiazolidinyl, piperidinyl, 2-ketopiperidinyl, 3-ketopiperidinyl, 4-ketopiperidinyl, acetylpiperazinyl, hexahydroazepinyl, or R1 and R2 when taken together with the nitrogen atom to which they are directly attached in formula (I), form a bicyclic ring system.

The above mentioned withdrawn products which are withdrawn from consideration as being for nonelected subject matter differ materially in structure and composition from the compounds of the elected invention. The withdrawn compounds differ from those of the elected invention, such as by pyrrolidinyl, thiazolidinyl, piperidinyl, piperazinyl, etc. which are chemically recognized to differ in structure and function. This recognized chemical diversity of the products can be seen by the various classification of these products in the U.S. classification system, i.e. class 548 subclass

Art Unit: 1626

(400)+ pyrrolidinyl, class 548 subclass (146)+ thiazolidinyl, class 546 subclass (184)+ piperidinyl, class 544 (358)+ piperazinyl, etc. Therefore, again, the compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in structure and composition and have been restricted properly as a reference which anticipated but the elected subject matter would not even render obvious the non-elected subject matter.

These withdrawn compounds are independent and distinct from the elected invention and do not have unity with the species elected and are therefore withdrawn by means of a restriction requirement within the claims.

The requirement is still deemed proper.

Claim Objections

Claims 160-170 are objected to as containing non-elected subject matter.

Claims 160-170 presented drawn solely to the elected invention identified supra as: **The elected invention for search and examination**, would appear allowable over the prior art of record.

Claim 160 is objected to because of the following informalities: The word "and" should be included between the structures (VII) and (VIII) as found on page 5 of the claims. Appropriate correction is required.

The closest prior art of record is US Patent No. 5,637,583 which discloses compounds for the treatment of arrhythmias of the formula I which differs from the instantly claimed compounds by the position equivalent to applicants' O-C(R₅)XA (R₅ is independently selected from hydrogen, C₁-6alkyl, aryl and benzyl) wherein in US Patent

Art Unit: 1626

NO. 5,637,583 the compound of formula I must have O-C(=O)XA which contains a carbonyl group which is not a possible substituent on applicants' instantly claimed compounds of the formula (I)


Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

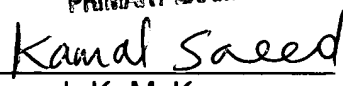
The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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